

## REMARKS

### **1. *Claim Rejections -- 35 U.S.C. § 112***

Claim 2 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 2 stands rejected for reciting the phrases “a quantity of Proxeronase present in said fruit juice” and “a quantity of Proxeronase present in said skin” in the claim, which phrases have been considered indefinite and vague. In response, Applicant has amended claim 2 to be more definite. Specifically, claim 2 has been amended to delete any reference to a general or specific amount or quantity of Proxeronase in either of the skin and/or the fruit juice said to interact with Proxeronine to trigger or cause the production of Xeronine.

### **2. *Claim Rejections -- 35 U.S.C. § 103***

Claims 1, 2, and 4-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the nonidrink.com advertisement ([www.nonidrink.com/skin\\_care.html](http://www.nonidrink.com/skin_care.html), “Tahitian Noni Juice information about noni juice,” copyrighted 1998-1999) (hereinafter referred to as “the advertisement”), in view of United States Patent Application No. 5,472,699 to Duffy (hereinafter referred to as “Duffy”); and United States Patent No. 5,228,491 to Moniz (hereinafter referred to as “Moniz”). Applicant appreciates the concerns raised by the Examiner, but respectfully submits that in light of the amendment to the claims as set forth above and the arguments presented below, neither the advertisement, nor Duffy nor Moniz, either individually or collectively, render the claims of the present invention obvious.

In response, Applicant submits that the advertisement is an improper prior art reference for the following reasons. First, the advertisement is hosted on a website of distributor of Morinda, Inc., the applicant of the present invention. This is evidenced by the statement

contained on the distributor's website and provided herein. See Exhibit A. Second, applicant submits that the advertisement comprises an improper copyright date. The copyright notice listed on the advertisement comprises a date range of 1998 – 1999. However, as is shown herein, this is an improper copyright notice that cannot be applied to all of the goods or products listed on that page or within the advertisement. Specifically, applicant is submitting an affidavit signed by an authorized representative of Morinda, Inc. averring to the release date of several of the products identified within the advertisement, as well as to the time of release of the several informational advertising, promotional, and other materials pertaining to these products. See Exhibit B. As can be seen, many of the products and materials pertaining to these products were released for public sale at much later dates than the copyright notice posted on the advertisement suggests. As such, Applicant submits that the copyright notice on the advertisement is incorrect and misleading because many of the products offered for sale (and their promotional items) were not available until July of 2000 or April of 2002, thus the distributor would have had no knowledge or access to such products or information prior to April 17, 2000.

Moreover, nonidrink.com is a website that is continually being updated. This is evidenced by the copyright notice appearing on the first or home page of the website. See Exhibit C. As such, applicant submits that the advertisement (which is part of the website) has continually been updated to reflect new products and information as it becomes available from applicant although the copyright notice on the advertisement was not updated. This would no doubt lead one to believe that the products were indeed released sometime between 1998 and 1999. However, as the supplied affidavit shows, these products were not available until several years after the dates listed in the copyright notice. As such, the advertisement may not be

considered proper prior art and Applicant respectfully requests that it be withdrawn from consideration.

As the advertisement has been shown to be improper prior art and found not to render the claims of the present invention obvious, Applicant incorporates its arguments submitted in prior responses and also submits that neither Moniz nor Duffy may be used either individually or in combination to render the claims of the present invention obvious.

Indeed, Moniz discloses a method for processing the *Morinda citrifolia* plant into powder. Although Moniz discloses that *Morinda citrifolia* fruit juice may be ingested by a patient to treat certain systemic disorders, Moniz neither discloses nor suggests topical application of a *Morinda citrifolia* fruit juice-containing compound, as disclosed by the present application. Moniz notes that the best chance of noni juice becoming activated is if the juice is taken on an empty stomach. See col. 3, ln. 12-17. Moniz would thus likely discourage one skilled in the art from applying noni juice topically.

Duffy, on the other hand, discloses a “method for reducing the visible size of facial skin pores by applying a novel composition which comprises an oil absorbing powder, a botanical astringent and a biological compound.” Duffy neither discloses nor suggests utilizing Noni fruit juice for any purpose whatsoever.

First, as argued previously, neither Moniz nor Duffy teach or disclose the *Morinda citrifolia* embodied in a topical cosmetic. Upon a careful reading of both Moniz and Duffy, it has been found that there is no suggestion in either of these references to embody a *Morinda citrifolia* product into a cosmetic skin toner. Also, there is no suggestion in either reference to combine the two to arrive at the claims of the invention as neither teach a cosmetic skin toner. Using language from the Federal Circuit in *In re Zurko*, 111 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed.

Cir. 1997), *rehearing in banc granted*, 116 F.3d 874 (Fed Cir. 1997), the court stated, “while in retrospect, looking at applicant’s invention, it might seem logical to perform [the step], neither [prior art reference] teaches [that step].” Therefore, not only must Moniz and Duffy be considered from the time of the invention, there is also nothing in Moniz nor Duffy that teaches a cosmetic skin toner. In addition, although the advertisement is an improper piece of prior art, the Examiner may not infer any teachings from the advertisement and apply them to either Moniz or Duffy or their combination. Indeed, the Examiner must read and analyze the disclosure in both Moniz and Duffy completely unaided by the advertisement, or without implying or any subject matter from the advertisement, as such would be considered improper hindsight reasoning. Moreover, as the test for obviousness is whether one ordinarily skilled in the art, *at the time of the invention*, would have considered the present invention obvious, it can be said that “[t]o imbue one of ordinary skill in the art with knowledge of the invention is suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” See *W.L. Gore & Associates, Inc. v. Garlock, Inc.* (Fed Cir. 1983).

In light of the foregoing, the advertisement is improper prior art and Applicant respectfully requests its withdrawal. Moreover, Duffy nor Moniz nor their combination render the claims of the present invention obvious, especially in light of the fact that hindsight reasoning is not permitted. As such, Applicant respectfully requests that the claims of the application be reconsidered and that the rejection under § 103 be withdrawn.

Each of the dependent claims place further limitations on what is otherwise argued allowable subject matter. Therefore, Applicant respectfully submits that these claims also stand in a condition for allowance.

CONCLUSION

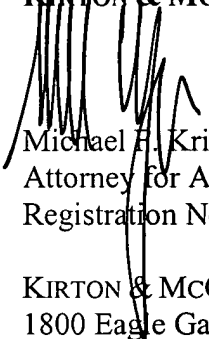
Based on the foregoing, Applicant respectfully submits that the deficiencies in the application have been corrected and that the proposed claims are not rendered obvious by the prior art references cited by the Examiner. As such, Applicant believes that the claims are now in a condition for allowance, and action to that end is respectfully requested.

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

DATED this 25 day of June, 2003.

Respectfully submitted,

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